



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,348	12/15/1999	MILAN M. SHAH	13768.122	7423

22913 7590 09/25/2002

WORKMAN NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER

BURGESS, BARBARA N

ART UNIT PAPER NUMBER

2157

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/464,348

Applicant(s)

SHAH ET AL.

Examiner

Barbara N Burgess

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 December 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 is rejected under U.S.C. 112, 2nd paragraph because it is unclear as to the meaning of the phrase “chain of commands”. Examiner will interpret this phrase as meaning multiple commands that may be executed, unless otherwise specified by the applicant.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Thurlow et al. (hereinafter “Thurlow”, 5,917,489).

As per claims 1, 12, and 23, Thurlow discloses a messaging system used for exchanging information, the system utilizing standard Internet protocol, a method for extending the protocol

Art Unit: 2153

to allow for the ability to customize messaging operations performed on an electronic message without deviating from the protocol specification, the method comprising the steps of:

- Storing a standard command, wherein the standard command is based on a standard Internet protocol (column 4, lines 52-56, 59-62, column 8, lines 6-12, 16-18);
- Storing a user-created command, wherein the user-defined command is based on extensions of the standard Internet protocol, and wherein the standard command and the user-created command are used for manipulating the message (column 1, lines 47-49, 66-67, column 2, lines 1-2, 12-13, 21-22, 33-34, column 3, lines 26-28, column 4, lines 52-56, 59-62, column 8, lines 6-12, 16-18, column 9, lines 15-23, 39-41, 51-52, column 11, lines 40-46);
- Constructing a chain of commands (column 9, lines 21-23, 27-28, 35-38, column 10, lines 41-53, column 12, lines 16-19, 22-24);
- Executing the chain of commands to manipulate the message (column 1, lines 31-38, column 2, lines 12-13, 21-22, column 3, lines 26-28, column 9, lines 37-38, column 16, lines 20-23).

As per claim 2, 13, and 24, Thurlow discloses:

- A method wherein the chain of commands is executed according to priority (column 9, lines 51-61).

As per claim 3, 14, and 28, Thurlow discloses:

- Constructing a chain of commands further includes determining if the standard command will be included in the chain of commands (column 7, lines 25-30, column 8, lines 6-9, column 16, lines 19-27).

Art Unit: 2153

As per claim 4, 15, and 27, Thurlow discloses:

- Constructing a chain of commands further includes determining if the user-defined command will be included in the chain of commands (column 1, lines 31-38, column 2, lines 51-53, column 7, lines 25-30, column 8, lines 6-9, column 9, lines 40-42, column 17, lines 10-12).

As per claim 5, 16, and 29, Thurlow discloses:

- A method wherein the step of constructing a chain of commands is initiated upon the raising of an event (column 2, lines 51-53, column 16, lines 63-67, column 17, lines 10-12, 16-19, 51-53).

As per claim 6 and 17, Thurlow discloses:

- A method wherein each command in the chain of commands relates to the raised event (column 2, lines 51-53, column 16, lines 63-67, column 17, lines 10-12, 16-19, 51-53).

As per claim 7, 18, and 25, Thurlow discloses:

- A method wherein the chain of commands includes a plurality of commands (column 9, lines 21-23, 27-28, 35-38, column 10, lines 41-53, column 12, lines 16-19, 22-24).

As per claim 8, 19, and 26, Thurlow discloses:

- A method wherein the chain of commands consists of one command (column 10, lines 43-44, column 11, lines 52-54, column 13, lines 4-7, column 14, lines 45-51).

Art Unit: 2153

As per claims 9-11, 20-22, and 30-32, Thurlow discloses:

- The standard command is stored in a first database (column 8, lines 41-46);
- The user-defined command is stored in a second database (column 8, lines 41-46);
- The first database and the second database are the same database (column 8, lines 41-46).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,199,102 B1

U.S. Patent No. 5,826,269

U.S. Patent No. 6,438,545 B1

U.S. Patent No. 6,212,535 B1

ISCREEN, described in *A Rule-Based Message Filtering System* by Stephen Pollock published in ACM Transactions on Office Information Systems, Vol. 6, No. 3, Jul. 1998, pages 232-254

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B Burgess can be reached on (703) 305-4792. The fax phone numbers for


Art Unit: 2153

the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess
Examiner
Art Unit 2153

September 12, 2002


ARIO ETIENNE
PRIMARY EXAMINER